

**REMARKS/ARGUMENTS**

In the Office Action, the Examiner noted that claims 1-29 are pending in the application and that claims 1-29 are rejected. By this response, claims 1-29 remain pending in this application. Applicants respectfully request reconsideration and assert that a prima facie case of obviousness has not been established.

**Rejections Under 35 U.S.C. §103**

In the instant Office Action, claims 1-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Vidyanand* (U.S. Patent 6,330,071) in view of *Suzuki et al.* (U.S. Patent 5,923,013). These rejections are respectfully traversed.

The Examiner has asserted that, regarding claims 1, 10, 15 and 21, *Vidyanand* discloses an apparatus for printing pages of a print job, comprising: a page analyzer operative to identify static page aspects and variable page aspects from print data within a print job, a converting apparatus communicating with a page analyzer and operative to convert the static page aspects into static page layout objects and the variable page aspects into variable print data. The Examiner acknowledges that *Vidyanand* does not disclose an identifying apparatus, an optimizer apparatus, a storage apparatus, and a merging apparatus, as recited with limitations in a claim. The Examiner then asserts that *Suzuki et al.* discloses an identifying apparatus communicating with the converting apparatus and operative to identify the static page layout objects in the manner allowing for an optimized form to be created and to allow for appropriate merging with the variable print data, an optimizer apparatus communicating with the identifying apparatus and operative to convert the static page layout objects to an optimized form, wherein optimization level to create the optimized form is based on intended usage of the static page layout objects by a user, a storage apparatus communicating with the optimizer apparatus and operative to store at least one instantiation of the static page layout objects in the optimized form, and a merging apparatus communicating with the storing apparatus and operative to merge the static page layout objects with the variable print data to create merge print data.

The Examiner then asserts that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify number 1407 of *Vidyanand's* invention with internal storage 12 of *Suzuki* unit and detection mechanism 1406 with the editing unit 22 of *Suzuki* to optimize the form based on users need according to the teaching of *Suzuki et al.*, where *Suzuki et al.* in the same field of endeavor teaches the way the static or master job could be combined as needed for the purpose of having the most optimized form possible for the user.

Applicants respectfully disagree with the Examiner and respectfully traverse the rejections herein of claims 1-29.

The Examiner has not established a prima facie case of obviousness. In order to establish a prima facie case of obviousness, the Examiner must provide 1) one or more references, 2) that were available to the inventor, and 3) that teach, 4) a suggestion to combine or modify the references, 5) the combination of modification or which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Here, the Examiner has not established a prima facie case of obviousness because *Vidyanand* and *Suzuki et al.* do not teach a suggestion to combine or modify the references such that the combination or modification would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

In the present case, the invention is not obvious because the prior art references of *Suzuki et al.* and *Vidyanand* only provide an "invitation to explore" even though the prior art could theoretically explain the invention. Here, there is no suggestion or motivation provided to render the claimed invention obvious. There is no statement in *Suzuki* that is sufficient to provide the necessary suggestion or modification to make the modification or combination. *Suzuki* merely teaches the sharing of print data among a plurality of print jobs to enhance data processing and data storage efficiency. In this way, a plurality of print jobs can share common page data. In contrast, *Vidyanand* teaches a variable data print job system that presents a print job as a two-part job with a first part that contains master data pages and a second part that contains variable data. The system places the master data in a buffer page

and copies it to another area of the page buffer so a page of the variable data can be overlaid onto the page buffer and then sent to a print engine for printing. The system can handle multiple masters with a print job that contains variable data group with associated master data. For example, a single print job is assembled with sequential variable data pages placed immediately after associated master pages in a serial fashion. A printer simply decodes the job serially and places the master data into memory whenever master data is encountered in the job stream. The system can also add master indexing to each page of a variable job. The master data is grouped in the front of a job with each variable page in the print job containing an index indicating the master data that it is associated with. The printer loads each master data into the page buffer that is called up through the variable page index. Additionally, the system can modify the traditional two-job approach with variable data containing a sub-index to the associated master page. A printer can find the appropriate master page, loaded into the page buffer, and overlay the variable page onto the master page.

There needs to be some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the references. It is well understood that the suggestion may come 1) expressly from the references themselves; 2) from knowledge of those skilled in the art that certain references, or disclosures in the references, are known to be of special interest or importance in a particular field; or 3) from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem. Accordingly, it is well established that obviousness cannot be established by combining the teachings of the prior art in order to produce the claimed invention, absent some teaching, suggestion or incentives supporting the combination.

Here, the Examiner has not provided such a teaching, suggestion or incentive which supports the combination. Applicants are at a loss as to what the incentive is, and the incentive is not readily apparent to Applicants. It is the duty of the Examiner to explain why combination of the reference teachings is proper. Absence such reasons or incentives, the teachings of the

references are not combinable (see *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (B.P.A.I. 1986)).

Furthermore, it is required that the suggestion or motivation to combine must have existed before the date of invention. It is incorrect for the Examiner to formulate the suggestion or motivation based on current knowledge. The Examiner must remove all knowledge that he or she has accumulated since the date of invention. As stated previously by the Fed. Cir., it is impermissible to use the claimed invention as an instruction manual or "template" in order to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that one cannot use hindsight reconstruction to pick and choose among the isolated disclosures in the prior art and to deprecate the claimed invention (see *In Re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (quoting *In Re Fine*, 837 F.2<sup>nd</sup> 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)). Here, the Examiner has used hindsight analysis. It is also understood that a general relationship between the fields of the prior art references is not sufficient in order to suggest a motivation to combine. There must be some motivation or suggestion to combine the prior art references. It is also not sufficient to use a high level of skill in the field to provide a suggestion or motivation. It is furthermore the case that the invention is not obvious where the Examiner fails to provide a suggestion even if prior art could have been combined. The mere fact that the prior art could have been combined is not sufficient.

It is even furthermore the case that the suggestion to combine the references cannot require substantial reconstruction or redesign of the prior art references in order to arrive at the claimed invention. Accordingly, if substantial reconstruction or redesign of the prior art references is necessary to arrive at the invention, an obviousness rejection is not appropriate (*In Re Ratti*, 270 F.2d 1810, 123 USPQ 349 (C.C.P.A. 1959)). Here, substantial reconstruction or redesign of the prior art references would be necessary in order to arrive at the invention in hand. Accordingly, Applicants take the position that it would not be obvious to a person of ordinary skill in the art at the time of the invention to modify *Vidyanand* with the features of *Suzuki et al.* The Examiner's mere statement that a purpose for making the modification is "to

optimize the form based on users need according to the teachings of *Suzuki et al.*, where *Suzuki et al.* in the same field of endeavor teaches the way the static or master job could be combined as needed for the purpose of having the most optimized form possible for the user." This statement does not provide a suggestion, motivation, or incentive to combine or modify the references.

Applicants herein respectfully request such a teaching, suggestion or motivation and respectfully traverse the rejection herein. Accordingly, Applicants respectfully request reconsideration of pending claims 1-29 and further restate the arguments presented in the last Office Action with regards to references *Vidyanand* and *Suzuki et al.*

### CONCLUSION

For all the reasons advanced above, Applicants respectfully submit that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

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